REMARKS

Claims 1-35 remain pending in the present application. No new matter has been added.

Double Patenting

The present office action states that Claims 1, 3, 9-15, 19-20, 22, 24 and 30-35 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 1-9 of copending Application No. 10/325,243.

A terminal disclaimer in compliance with 37 CFR § 1.321(c) is being submitted concurrent with the instant response, thereby obviating the double patenting rejection.

The present office action states that Claims 1, 3, 9-15, 19-20, 22 and 30-35 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 1-3 and 5-9 of copending Application No. 10/364,643.

A terminal disclaimer in compliance with 37 CFR § 1.321(c) is being submitted concurrent with the instant response, thereby obviating the double patenting rejection.

Claim Rejections - 35 U.S.C. §112

The present office action states that Claims 1-35 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

Claims 1-2, 4-10, 13, 15-16, 18-20, 22-23, 25-31 and 34 are rejected under 35 U.S.C. § 112, second paragraph, as containing the trademark/trade name(s): iTunes, iPod, Macintosh and Windows.

In the previous OA mailed August 07, 2007, Applicants respectfully disagreed with the rejection and pointed out section 2173.05(u) of the MPEP, "The presence of a

trademark or trade name in a claim is not, per se, improper under 35 U.S.C. 112, second paragraph." and section 608.01(v) of the MPEP, "If the trademark has a fixed and definite meaning, it constitutes sufficient identification unless some physical or chemical characteristic of the article or material is involved in the invention."

Further, Applicants respectfully submit, **MPEP 608.01(v) "**Trademarks and Names Used in Trade [R-2]" The expressions "trademarks" and "names used in trade" as used below have the following meanings: Trademark: a word, letter, symbol, or device adopted by one manufacturer or merchant and used to identify and distinguish his or her product from those of others. It is a proprietary word, letter, symbol, or device pointing distinctly to the product of one producer.

Names Used in Trade: a nonproprietary name by which an article or product is known and called among traders or workers in the art, although it may not be so known by the public, generally. Names used in trade do not point to the product of one producer, but they identify a single article or product irrespective of producer. Names used in trade are permissible in patent applications if: (A)Their meanings are established by an accompanying definition which is sufficiently precise and definite to be made a part of a claim, or (B) In this country, their meanings are well-known and satisfactorily defined in the literature. Condition (A) or (B) must be met" (emphasis added).

In the present OA mailed 2.1.08, page 5 states, "[f]or the sake of examining, the examiner will assume iTunes to be a media player, iPod to be a media playing device, and Macintosh and Windows to be any operating system" (emphasis added).

Applicants respectfully disagree with this statement and approach. Applicants respectfully point out that Macintosh and Windows are not any operating system, but are in fact specific operating systems. Further, the Applicants respectfully contend that no computer user would be confused about which operating system is being used by his or her computing system and if asked would quickly and clearly answer with the appropriate O/S. Further, Applicants respectfully submit if a user were utilizing and O/S that was not

Windows or Macintosh, the user would be even quicker to not only name the O/S that was in use, but also quick to extol the virtues, advantages, and logic behind the selection of O/S.

Thus, Applicants respectfully submit that, in this country, and in the present Office Action, the meaning of the term(s) "iTunes", "iPod", "Macintosh" and "Windows" is well-known and satisfactorily defined in the literature as having a fixed and definite meaning to provide sufficient identification of the operating system characteristics. In addition, Applicants contend that the term(s) "iTunes", "iPod", "Macintosh" and "Windows" is more than simply a trademark or trade name but is, in fact, a term of art as shown in the Office Action. In other words, Applicants contend that a reference to Mac O/S (e.g., Mac) or Windows O/S (e.g., PC) is presently the only way most, if not all, computer users refer to their computers in general. Further, most, if not all, software, hardware and periphery computer items provide similar segregation, e.g., Mac O/S and/or Windows O/S compatibility.

Further, Applicants respectfully submit that the meaning of the term(s) "iTunes", "iPod", "Macintosh" and "Windows" is clearly provided in the present Specification at least at page 139 lines 10-25: "Figure 20 is an exemplary logic/bit path block diagram 2000 showing utilization of a copyright compliance mechanism 300 (of Figure 3), for selectively controlling recording of copyrighted media received by a Macintosh® (sometimes referred to as Apple®) computer system, (e.g., system 210), in one embodiment of the present invention. Copyright compliance mechanism (CCM) 300 is, in one embodiment, installed and operational on Macintosh® operating system in the manner described herein. Additionally, all rules and issues described herein regarding the CCM 300 and the media being controlled by the CCM 300 mechanism are enforced. The only difference is the method in which the CCM 300 apparatus is organized on the Macintosh® operating system (O/S). Although in one embodiment, CCM 300 is installed on the Macintosh® operating system, in another embodiment, the CCM 300 may be invoked by the Macintosh® operating system through a plurality of methods including system and periphery multimedia rendering applications (e.g., an iTunes

player®, a CD player, a DVD player, a downloaded multimedia application, an MP3 player, or the like.)"

For these additional reasons, Applicants respectfully submit the rejection of Claims 1-31 under 35 U.S.C. § 112, second paragraph, based on the presence of the trademark(s) "iTunes", "iPod", "Macintosh" and "Windows" is improper and should be withdrawn as Macintosh operating system or MAC O/S has a fixed and definite meaning and there is no other term known to the Applicants which will provide as sufficient identification of the operating system characteristics as the term(s) "iTunes", "iPod", "Macintosh" and "Windows".

Claim Rejections - 35 U.S.C. §103

Claims 1-20 and 22-35

The present office action states that Claims 1-20 and 22-35 are rejected under 35 U.S.C. § 103(a) as being obvious over Doherty et al. (6,920,567) in view of Pastorelli et al. (2004/0133801). Applicants have reviewed the cited reference and respectfully submit that the embodiments of the present invention as recited in Claims 1-20 and 22-35 are not taught or rendered obvious over Doherty et al. in view of Pastorelli et al. for the following reasons.

With regard to Claim 1 (and similarly Claims 15 and 22), Applicants respectfully state that Claim 1 includes the feature "controlling a data output path of said client system with said compliance mechanism by diverting a commonly used data pathway of said media content presentation application to a controlled data pathway monitored by said compliance mechanism" (emphasis added). Support for the Claimed feature can be found throughout the Figures and Specification including Figures 3 and pages 20 lines 10-17 and 21 lines 5-8.

Further, Applicants respectfully agree with page 6 of the present Office Action that states, "Doherty et al. does not teach diverting a commonly used data pathway of

said media content presentation application to a controlled data pathway monitored by said compliance mechanism" (emphasis added).

In order to establish a *prima facie* case of obviousness, the prior art must suggest the desirability of the claimed invention (MPEP 2142). In particular, "if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious" (emphasis added) (MPEP 2143.01; *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)).

Applicants understand Doherty et al. to teach interrupting the common pathway or stream (emphasis added). That is, Applicants understand Doherty to teach that an attempted access is intercepted and subjected to the monitoring and validation by the license monitor and control mechanism. As such the common pathway or stream of digital content is interrupted by this security feature and a validation must be successful in order to allow a user access to the digital content. (see column 4, lines 54-60) (emphasis added).

Further, Applicants understand Pastorelli et al. to teach, "[C]ompliance of the execution request with authorised conditions of use of the product is verified, and starting of the product **is** enabled **or** prevented according to the result of the verification" ([0045]) (emphasis added). Further, page 6 of the present Office Action supports this understanding of Pastorelli et al.

Thus, Applicants respectfully submit that the feature "controlling a data output path of said client system with said compliance mechanism by diverting a commonly used data pathway of said media content presentation application to a controlled data pathway monitored by said compliance mechanism" (emphasis added); is not taught or render obvious over Doherty et al. or Pastorelli et al. and, in fact, would change the method of operation of both Doherty et al. and Pastorelli et al.

In other words, Applicants respectfully submit that Doherty et al. and Pastorelli et al. presently addresses the same problem as the present invention and provide distinctly different solutions to the same problem. As such, Applicants respectfully submit that the modification of Doherty et al. in view of Pastorelli et al. as suggested by the present Office Action is unsupported by teachings of either Doherty et al. or Pastorelli et al. and is based on improper application of hindsight and that the differences between these approaches would not have prompted a person of ordinary skill in the relevant field to combine the elements in the way the instant claims require.

Thus, Applicants respectfully submit the present rejection rests on speculation and less than a preponderance of the evidence and thus, fails to provide sufficient reasons for finding claims 1-20 and 22-35 unpatentable for obviousness under 35 U.S.C. 103(a) over Doherty et al. in view of Pastorelli et al.

For this reason, Applicants respectfully submit that Doherty et al. in view of Pastorelli et al. does not teach or render obvious the features Claimed in Claims 1, 15 and 22. As such, Applicants respectfully submit that Claims 1, 15 and 22 are not taught or rendered obvious by Doherty et al. in view of Pastorelli et al.

With respect to Claims 2-14, Applicants respectfully state that Claims 2-14 depend from the allowable Independent Claim 1 and recite further features of the present claimed invention. With respect to Claims 16-20, Applicants respectfully point out that Claims 16-20 depend from the allowable Independent Claim 15 and recite further features of the present claimed invention. With respect to Claims 23-35, Applicants respectfully point out that Claims 23-35 depend from the allowable Independent Claim 22 and recite further features of the present claimed invention. Therefore, Applicants respectfully state that Claims 2-14, 16-20 and 23-35 are at least allowable as pending from allowable base Claims.

Claim 21

In the Office Action, Claim 21 is rejected under 35 USC 103(a) as being unpatentable over Doherty et al. and Pastorelli et al. in view of Rhoads et al. (6,422,285). Applicants have reviewed the cited reference and respectfully submit that the present invention is not rendered obvious over Doherty et al. in view of Rhoads et al. for the following rationale.

Applicants respectfully submit that Claim 15 includes the feature "A method for preventing unauthorized recording of media content on a Macintosh operating system comprising:

registering a compliance mechanism on a client system having said Macintosh operating system operating thereon, said compliance mechanism comprising:

a framework for validating said compliance mechanism on said client system; and

a multimedia component opened by said framework, said multimedia component for decrypting said media content on said client system; and

preventing decryption of said media content **on said client system** having said Macintosh operating system operating thereon **if a portion of** said compliance mechanism is invalidated." (emphasis added).

For the reasons previously provided herein, Applicants respectfully submit that Claim 15 is not render obvious by Doherty et al. in view of Pastorelli et al. Moreover, the combination Doherty et al. and Pastorelli et al. in view of Rhoads et al. does not overcome the shortcomings of Doherty et al. in view of Pastorelli et al. As such, Applicants respectfully submit that Claim 15 is presently allowable.

With respect to Claim 21, Applicants respectfully submit that Claim 21 depends from the allowable Claim 15 and recites further features of the present claimed invention. Therefore, Applicants respectfully state that Claim 21 is at least allowable as pending from an allowable base Claim.

CONCLUSION

Based on the amendments herein and arguments presented above, Applicants respectfully assert that Claims 1-35 overcome the rejections of record, and therefore, Applicants respectfully solicit allowance of these Claims.

The Examiner is invited to contact Applicants' undersigned representative if the Examiner believes such action would expedite resolution of the present Application.

Respectfully submitted,
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